

### **REMARKS**

Applicants acknowledge with thanks the personal interview granted by the Examiner on May 2, 2006.

Claims 2-19 are pending in this application. With this amendment, claim 10 is cancelled, claims 2, 5, 17 and 18 are amended. New claim 20 is added.

New claim 20 depends from independent claim 2 and recites the use of at least one of the plurality of transponders to provide the position of at least one of plurality of the selectively steerable segments. This claim is supported by, at least, paragraph [0075] and FIGs. 24-26. No new matter has been added and new claim 20 is patentable for at least the reasons set forth below with regard to claim 2.

### **OBJECTIONS TO THE SPECIFICATION**

The Examiner has objected to the outdated continuity data in the first paragraph. Applicants have amended the first paragraph to reflect updated continuation data as requested by the Examiner.

The Examiner has objected to the abstract. Applicants have provided a replacement abstract as requested by the Examiner.

Applicants have appropriately addressed the objections raised by the Examiner and respectfully requests that the objections to the specification be withdrawn.

### **OBJECTIONS TO THE CLAIMS**

Applicants have amended claim 2 as suggested by the Examiner. Applicants note that the erroneous "herein" appeared in and was corrected in claim 18, not claim 17. Applicants have appropriately addressed the objections raised by the Examiner and respectfully requests that the objections to the claims be withdrawn.

**CLAIM REJECTIONS – 35 U.S.C. §112**

Claims 10 and 17 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 10 has been cancelled.

Claim 17 has been rejected because “the electronic memory” lacks antecedent basis. Claim 17 has been amended to more particularly point out and distinctly claim that which the Applicants regard as their invention by removing the term “the electronic memory” from the claim. Amended claim 17 now recites using a three dimensional model stored in an electronic motion controller to control the steerable instrument.

**CLAIM REJECTIONS – 35 U.S.C. §102**

Claims 2-4, 6-11 and 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Taniguchi et al. (U.S. Pat. 6,511,417, “Taniguchi”).

Anticipation requires that every element of a claim be present in a single reference. Independent claims 2 and 11 have been amended to recite an instrument having an elongate body, a selectively steerable distal end and a plurality of selectively steerable segments. Taniguchi only describes a conventional endoscope that lacks any mention of an instrument having selectively steerable distal end and a plurality of selectively steerable segments. Because Taniguchi lacks any description of an instrument having a selectively steerable distal end and a plurality of selectively steerable segments, Taniguchi cannot anticipate claims 2 and 11. Applicants respectfully request that the rejection of independent claims 2 and 11 be withdrawn. Dependent claims 3, 4, 6-10 and 13-19 depend from either independent claim 2 or 11 and are patentable over Taniguchi for at least the same reason set forth above. Claims 2-4, 6-11 and 13-19 are therefore allowable.

**CLAIM REJECTIONS – 35 U.S.C. §103**

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grundl et al. (U.S. Pat. 5,586,968, “Grundl”). Claim 5 has been amended to recite a datum speculum that produces a signal indicative of the axial position of the instrument. The tube 16 in Grundl is introduced into the anus

to prevent the patient from closing the anal sphincter muscle (Grundl, Col. 7, lines 23-25). There is no mention in Grundl of obtaining any position information for an instrument passing through the tube 16 or modifying the tube 16 to produce a signal indicative of the axial position of an instrument in the tube 16. As such, Grundl does not render obvious amended claim 5. Applicants respectfully request that the rejection of claim 5 under Grundl be withdrawn.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi. Claim 12 depends from amended independent claim 11 that now recites the use of an instrument having an elongate body with a selectively steerable distal end, and a plurality of selectively steerable segments. Moreover, claim 12 has been amended to recite that the instrument is advanced past a datum speculum that produces a signal indicative of the axial position of the instrument and through an incision. For the reasons set forth above with regard to the rejections of claims 2, 11 and 5, Taniguchi provides no suggestion or motivation to provide the features claimed. As such, Taniguchi does not render obvious amended claim 12.

**CONCLUSION**

Having addressed all the objections and rejections raised by the Examiner, Applicants submit that pending claims 2-9 and 11-20 are in condition for allowance, which is respectfully requested. Should the Examiner have any questions, the Examiner is requested to contact the undersigned attorney.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 26427-704.302).

Respectfully submitted,

Date: 6/23/06

By: WBG  
W. Benjamin Glenn  
Registration No. 44,713

WILSON SONSINI GOODRICH & ROSATI  
650 Page Mill Road  
Palo Alto, CA 94304-1050  
(650) 849-3425  
Client No. 021971